

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION OF:) Electronically Filed on May 8, 2007
)
Horsnell, et al.)
)
)
SERIAL NO.: 10/521,686)
)
FILED: September 19, 2005)
)
FOR: Printing Device And Method)
Using Valve Control)
)
ART UNIT: 2853)
)
EXAMINER: Uhlenhake, Jason S.)
)
Confirmation No. 2174)

PRE APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

Date: May 8, 2007

By: /Joseph M. Butscher/
Joseph M. Butscher
Reg. No. 48,326
Attorney for Applicants

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775 - 8100

REMARKS

The present application includes pending claims 1-4, all of which remain rejected. Claims 1-4 remain rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2134045 ("Slomianny") and United States Patent No. 4,567,570 ("Peer").

The Office Action acknowledges that Slomianny does not disclose certain limitations of the pending claims. See February 26, 2007 Office Action at page 3, and August 14, 2006 Office Action at page 3, and April 19, 2007 Response at page 5.

In order to overcome these deficiencies, the first Office Action cited Peer at column 1, line 65 to column 2, line 13, column 5, lines 3-35, and column 6, lines 19-30 as disclosing the limitations that are not found in Slomianny. See August 14, 2006 Office Action at pages 3-4. The final Office Action also cites Peer at lines 5-19, column 8, lines 35-40, and Figure 6. See February 26, 2007 Office Action at pages 4-5.

However, none of these portions of Peer describe, teach, or suggest the limitations that the Office Action acknowledges are missing from Slomianny. See April 19, 2007 Response at pages 6-12. Thus, for at least these reasons, the Office Action has not established a *prima facie* case of obviousness with respect to the pending claims.

Additionally, the Office Action does not identify a proper motivation to combine the references. See *id.* at pages 12-14. Thus, for at least this reason, the Office Action has not established a *prima facie* case of obviousness with respect to the pending claims.

The Supreme Court's decision in *KSR International v. Teleflex* notwithstanding, "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in

the art would have combined the prior art elements in the manner claimed.” *See* May 3, 2007 Memo from Margaret A. Focarino to Technology Center Directors. A mere summary of elements allegedly disclosed in certain references (as exhibited in the February 26, 2007 Office Action) is not a proper identification of a motivation to combine. *See* April 19, 2007 Response at pages 12-16.

The Applicants respectfully submit that the pending claims of the present application should be in condition for allowance for at least the reasons discussed above, and request reconsideration of the claim rejections. Please charge any necessary fees, including the \$500 fee for the Notice of Appeal, or credit any overpayment to Account No. 13-0017.

Respectfully submitted

Date: May 8, 2007

By:

/Joseph M. Butscher/

Joseph M. Butscher

Reg. No. 48,326

Attorney for Applicants

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100